

REMARKS

In response to the Office Action mailed May 16, 2003, Applicants have amended claims 1, 16 and 21, and cancelled claim 7. Claims 1-6, 8-10, 14-16 and 18-24 are presented for examination.

The Examiner rejected claims 1-6, 8, 10, 14, 15 and 21-24 under 35 U.S.C. §102(b) as being anticipated by Narayanan. As amended, these claims cover compositions that have a total amount of non-electrolytic material that is less than about 30 percent of the composition by weight. In contrast, Narayanan discloses that his material contains a much larger total amount of non-electrolytic material (60%-70% NAFION plus 15%-20% TFE-30, resulting in a total amount of non-electrolytic material of from 75%-90%). (Narayanan col. 3, line 58-col. 4, line 4). Thus, Narayanan does not disclose the compositions covered by claims 1-6, 8, 10, 14, 15 and 21-24, so Applicants request reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. §102(b).

The Examiner also rejected claims 16 and 18-20 under 35 U.S.C. §102(b) as being anticipated by Narayanan. As amended claims 16 and 18-20 cover compositions including a catalyst and a material resistant to oxidation up to about 3.0 Volts vs. SHE, where the catalyst is distributed on the material with a load of between about 0.025 mg/cm<sup>2</sup> to 1.0 mg/cm<sup>2</sup>. Narayanan does not disclose such a composition, so Applicants request reconsideration and withdrawal of the rejection of claims 16 and 18-20 under 35 U.S.C. §102(b).

The Examiner rejected claim 9 as under 35 U.S.C. §103(a) as being unpatentable over Narayanan in view of Mitsunaga. Claim 9 depends from claim 1, which is discussed above, where it is demonstrated that Narayanan does not disclose the subject matter covered by these claims. Mitsunaga does not cure Narayanan's infirmities at least because, like Narayanan, Mitsunaga fails to disclose compositions that have a total amount of non-electrolytic material that is less than about 30 percent of the composition by weight, as required by claim 9. Thus, without conceding that such a combination could be made or is even suggested, even if Narayanan and Mitsunaga were combined, the result would not be the compositions covered by

claim 9. Applicants therefore request reconsideration and withdrawal of the rejection of claim 9 claim 9 as under 35 U.S.C. §103(a).

The Examiner rejected claims 1-6, 8-10, 14-16 and 18-24 under 35 U.S.C. §112, first paragraph because, in the Examiner's view, the application as originally filed does not provide a written description that supports the composition being "substantially free of carbon fibers." In particular, the Examiner noted that the application incorporates by reference Wilson, U.S. Patent No. 5,211,984 ("Wilson"), which the Examiner asserts discloses electrode supports that include carbon supported catalysts. The Examiner then concludes that the application lacks a clear teaching of the "negative limitation" (substantially free of carbon fibers).

Nowhere does Wilson disclose fibers of the type excluded by the pending claims. While Wilson does disclose an element (catalyst layer) that contains carbon, the carbon is in the form of particles, not fibers. (See, e.g., Wilson col. 3, lines 29-38 and Figs. 1 and 2). One skilled in the art would certainly understand that, if Wilson intended to disclose carbon fibers, he would have done so, particularly where Wilson explicitly discloses carbon particles. In other words, one skilled in the art would recognize that Wilson discloses an electrode that is substantially free of carbon fibers.

Applicants incorporate by reference their prior arguments regarding the written description requirement of 35 U.S.C. §112, first paragraph. Applicants disagree with the Examiner's view, which Applicants regard as being contrary to the decision by the Board of Appeals and Patent Interferences in Ex parte Parks, 30 U.S.P.Q.2d 1234 (B.P.A.I. 1994).

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

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